



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,542	05/30/2000	Shigeyuki Kawai	SON-1844	1556

23353 7590 02/27/2002

RADER FISHMAN & GRAUER PLLC
LION BUILDING
1233 20TH STREET N.W., SUITE 501
WASHINGTON, DC 20036

EXAMINER

FRANKLIN, JAMARA ALZAIDA

ART UNIT	PAPER NUMBER
----------	--------------

2876

DATE MAILED: 02/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/580,542

Applicant(s)

KAWAI ET AL.

Examiner

Jamara A. Franklin

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 and 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to because in fig. 15 “classeify” should be substituted with --classify--. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 9 is objected to because of the following informalities:
on line 5 of the claim, substitute “be” with --is--.
Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 3, 14, and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 3, line 2: the addition of the word “type” to an otherwise definite expression

Art Unit: 2876

(e.g. a contactless information card) extends the scope of the expression so as to render it indefinite. Appropriate correction is required to alleviate the indefiniteness of the language “contactless-type information card” as recited in claim 3. See M.P.E.P. 2173.05 (b).

Re claims 14 and 15: the addition of the word “type” to an otherwise definite expression (e.g. a card storage medium) extends the scope of the expression so as to render it indefinite. Appropriate correction is required to alleviate the indefiniteness of the language “card-type storage medium” as recited in claims 14 and 15. See M.P.E.P. 2173.05 (b).

Appropriate clarification and correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, 5-14, and 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Hogan (US 5,557,516).

Hogan teaches a financial card 100, with corresponding user bank account, for use for transactions with a sales/transaction terminal 307. The terminal 307 processes data (identification and financial) stored in a memory 201 of the card 100. Other data stored in the memory is last date and time of purchases (col. 5, lines 11-64). The balance on the card 100 is reduced to account for the price of the item purchased. If the balance on the card 100 is insufficient to cover the purchase price, and a maximum number of renewals has not been

Art Unit: 2876

reached, an automatic renewal is triggered by the terminal 307 to increase the balance by \$25 (col. 6, lines 31-46). An issuer computer 303 periodically bills the card 100 user \$25 (col. 10, lines 34-38). A detailed statement is generated every month and sent as the card 100 user's regular credit card bill (col. 11, lines 59-61).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 3 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan in view of Iijima (US 5,517,014). The teachings of Hogan have been discussed above.

Hogan lacks the teaching of contactless information card.

Iijima teaches the possible use of a noncontact IC card in place of a contacting IC card

Art Unit: 2876

(col. 9, lines 56-61).

One of ordinary skill in the art would have readily recognized that to substitute a contacting information card with a contactless information card would have been beneficial since, with a contactless card, a user has faster access to the data stored on the card because the card need only be presented to the reading device as opposed to physically inserted and ejected from a terminal slot. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Hogan with the aforementioned contactless information card as taught by Iijima.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan in view of Tateisi et al. (US 3,648,020) (hereinafter referred to as 'Tateisi'). The teachings of Hogan have been discussed above.

Hogan lacks the teaching of a money deposit terminal.

Tateisi teaches an automatic deposit-receiving and cash-dispensing machine featuring means for allowing a customer to deposit bills and/or coins to update the customer's account stored on a card 10 (col. 2, lines 18-30 and col. 4, lines 56-73).

One of ordinary skill in the art would have readily recognized that the advantage of providing a money deposit terminal to the invention of Hogan is that the user would have then been able to replenish the monetary amount of the card, thereby giving the user instant and flexible accessibility to the value of the card. Therefore, it would have been obvious, at the time the invention was made, to modify the teachings of Hogan with the money deposit terminal as taught by Tateisi.

Art Unit: 2876

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Tomoyuki et al. (US 5,991,747) teach an electronic purse loan system.

Nonaka et al. (JP 09044576 A) teach an electronic purse lending system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamara A. Franklin whose telephone number is (703) 305-0128. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703)308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.


Jamara A. Franklin
Examiner
Art Unit 2876

JAF
February 20, 2002


MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800